



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,206	10/30/2001	Adam C. Bacile	081276-9067-00	4373

7590 04/23/2003

David R. Price  
Michael Best & Friedrich LLP  
100 East Wisconsin Avenue  
Milwaukee, WI 53202-4108

EXAMINER

PEREZ, GUILLERMO

ART UNIT PAPER NUMBER

2834

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/016,206

Applicant(s)

BACILE ET AL.

Examiner

Guillermo Perez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 23-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1001.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a motor housing, classified in class 310, subclass 51.
- II. Claims 23-40, drawn to a method of assembling an HVAC unit, classified in class 29, subclass 450.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the machine can be made by:

molding the housing with the first isolating material in one piece on the partially closed end, around the casing of the motor;

remove a mold from between the housing and the casing to leave a space between them except where the isolator is located;

close the housing with the isolator-end cap part.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Richard Kaiser on April 17, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22. Applicant in replying to this Office action must make affirmation of this election. Claims 23-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 9-12, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. B. Newill et al. (U. S. Pat. 2,093,471) in view of Kirkwood (U. S. Pat. 6,021,993).

E. B. Newill et al. disclose a motor housing assembly for housing a motor (15), the motor (15) having a casing (19) defining an axial length and an output shaft (30) extending from the casing (19), the motor housing assembly comprising:

a housing defining a cavity with an open end for receiving the motor (15) and a partially closed end opposite the open end such that the output shaft (30) can extend from the partially closed end but the motor (15) cannot be removed from the housing through the partially closed end, the housing having a length larger than the axial length of the casing (19) such that the entire casing (19) of the motor (15) can be received within the cavity;

an end cap configured to substantially close the open end of the housing and retain the motor (15) in the housing;

a first isolator member (41) configured to be sandwiched between the casing (19) and the end cap to substantially isolate the motor (15) from both the housing and the end cap; and

a second isolator member (43) configured to be between the casing (19) and the housing to substantially isolate the motor (15) from the housing.

However, E. B. Newill et al. do not disclose that the second isolator member is configured to be sandwiched. E. B. Newill et al. do not disclose that the first isolator member is integrally formed with the end cap. E. B. Newill et al. do not disclose that the first isolator member includes a plurality of projections configured to be received in a corresponding plurality of apertures in the end cap to substantially prevent relative movement between the first isolator member and the end cap. E. B. Newill et al. do not

disclose that the second isolator member is sandwiched between the casing and the partially closed end of the housing.

Kirkwood discloses that the second isolator member (82) is configured to be sandwiched. Kirkwood discloses that the first isolator member (46) includes a plurality of projections (48) configured to be received in a corresponding plurality of apertures in the end cap (50) to substantially prevent relative movement between the first isolator member (46) and the end cap (50). Kirkwood discloses that the second isolator member (82) is sandwiched between the casing (22) and the partially closed end of the housing (64). Kirkwood's invention has the purpose of reducing the vibrations transmitted from the motor.

It would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E. B. Newill et al. and provide it with the isolator configuration disclosed by Kirkwood for the purpose of reducing the vibrations transmitted from the motor.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the first isolator member integral with the end cap since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U. S. 164 (1893).

2. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. B. Newill et al. in view of Kirkwood as applied to

claims 1 and 12 above, and further in view of Martin (U. S. Pat. 6,538,350).

E. B. Newill et al. and Kirkwood substantially teach the claimed invention except that it does not show that the housing includes a notch configured to receive an electrical connector of the motor. Neither E. B. Newill et al. nor Kirkwood disclose that the motor housing assembly further includes a piece of sealing and vibration isolating material coupled to the housing adjacent the notch.

Martin discloses that the housing (2) includes a notch configured to receive an electrical connector (5) of the motor. Martin discloses that the motor housing assembly further includes a piece of sealing and vibration isolating material (14) coupled to the housing adjacent the notch. Martin's invention has the purpose of tightly enclosing the electrical connectors.

It would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E. B. Newill et al. and Kirkwood and provide it with the notch and the isolating material disclosed by Martin for the purpose of tightly enclosing the electrical connectors.

3. Claims 3-5, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. B. Newill et al. in view of Kirkwood as applied to claims 1 and 12 above, and further in view of Czech et al. (U. S. Pat. 4,128,935).

E. B. Newill et al. and Kirkwood substantially teach the claimed invention except that it does not show that the housing includes a mounting flange extending radially

from the housing between the open end and the partially closed end for mounting the housing to a vehicle. Neither E. B. Newill et al. nor Kirkwood disclose that the mounting flange includes a plurality of mounting holes for receiving fasteners. Neither E. B. Newill et al. nor Kirkwood disclose that the housing includes a plurality of locking tabs adjacent the mounting flange.

Czech et al. disclose that the housing (17) includes a mounting flange (26) extending radially from the housing (17) between the open end and the partially closed end for mounting the housing (17) to a vehicle. Czech et al. disclose that the mounting flange (26) includes a plurality of mounting holes for receiving fasteners (37). Czech et al. disclose that the housing (17) includes a plurality of locking tabs (36) adjacent the mounting flange (26). The invention of Czech et al. has the purpose of fixing together the housing assembly components.

It would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E. B. Newill et al. and Kirkwood and provide it with the flange and tab configuration disclosed by Czech et al. for the purpose of fixing together the housing assembly components.

4. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. B. Newill et al. in view of Kirkwood as applied to claims 1 and 12 above, and further in view of Schoen (U. S. Pat. 4,071,794).

E. B. Newill et al. and Kirkwood substantially teach the claimed invention except that it does not show that the housing includes a plurality of resilient locking tabs

adjacent the open end and configured to engage the end cap such that the end cap can be coupled to the open end without the use of tools or fasteners.

Schoen discloses that the housing (3) includes a plurality of resilient locking tabs (12) adjacent the open end and configured to engage the end cap (24) such that the end cap (24) can be coupled to the open end without the use of tools or fasteners. Schoen's invention has the purpose of receiving and locking a housing cover member.

It would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E. B. Newill et al. and Kirkwood and provide it with the locking tabs disclosed by Schoen for the purpose of receiving and locking a housing cover member.

5. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. B. Newill et al. in view of Kirkwood as applied to claims 1 and 12 above, and further in view of Geberth Jr. (U. S. Pat. 4,908,538).

E. B. Newill et al. and Kirkwood substantially teach the claimed invention except that it does not show that the partially closed end is defined by a plurality of ribs.

Geberth Jr. discloses that the partially closed end is defined by a plurality of ribs (between the holes 88). The invention of Geberth Jr. has the purpose of drawing outside air into the housing compartment.

It would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E. B. Newill et al. and Kirkwood and provide it with the ribs

disclosed by Geberth Jr. for the purpose of drawing outside air into the housing compartment.

6. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. B. Newill et al. in view of Kirkwood as applied to claims 1 and 12 above, and further in view of Bartlett (U. S. Pat. 6,262,504).

E. B. Newill et al. and Kirkwood substantially teach the claimed invention except that it does not show that the housing includes a baffle portion adjacent the air inlet aperture to provide cooling airflow into the cavity.

Bartlett discloses that the housing includes an air inlet aperture (142) communicating with the cavity, and a baffle portion (140) adjacent the air inlet aperture (140) to provide cooling airflow into the cavity. Bartlett's invention has the purpose of improving the cooling capabilities inside the housing.

It would have been obvious at the time the invention was made to modify the HVAC drive unit disclosed by E. B. Newill et al. and Kirkwood and provide it with the baffle disclosed by Bartlett for the purpose of improving the cooling capabilities inside the housing.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Guillermo Perez whose telephone number is (703) 306-5443. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

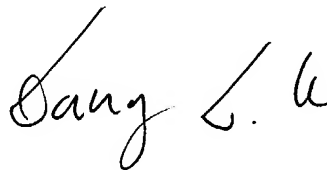
Application/Control Number: 10/016,206  
Art Unit: 2834

Page 10

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308 1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305 3432 for regular communications and (703) 305 3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

Guillermo Perez  
Friday, April 18, 2003

A handwritten signature in cursive script, appearing to read "Dang L. Le".

DANG LE  
PRIMARY EXAMINER